

PATENT

REMARKS

This paper is responsive to the Office Action dated August 12, 2005. Claims 1-40 were examined. Of those, claims 14-16, 34, 35 and 38-40 have been allowed. Claim 29 has been indicated as containing allowable subject matter but is objected to as being dependent on a rejected base claim. The remaining claims are rejected. New claims 41-43 have been added.

The rejections are traversed-in-part and in-part overcome by clarifying amendments. Reconsideration and further examination are respectfully requested.

Rejection Under 35 U.S.C. §102

Claims 1-8, 11, 13, 18-19, 25-27, and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,426,422 issued to Vanden Heuvel et al. (hereinafter "Vanden Heuvel").

Claim 1

In rejecting claim 1, the Office asserts that Vanden Heuvel teaches a method of presenting information on a space-constrained display of a portable device (e.g., displaying on an LCD "of limited size"), the method comprising: associating a first indication on the display (e.g., triangle 206a) with a user-defined external state (e.g., a "screen of information" "previously flagged by the user"); establishing a user-defined operation (e.g., "flagging") for monitoring the user-defined external state; and updating the first indication (e.g., setting an icon for "unread" operation) on the display in accordance with the monitored user-defined external state in response to an information encoding thereof received via a telecommunications network.

Applicant respectfully disagrees with the Office's assertion that Vanden Heuvel teaches "associating a first indication on the display with a user-defined external state." As explained in previous communications, mere display of a screen of information, as described in the passage cited in the Office Action (abstract; column 2, lines 27-59), does not constitute "establishing an association" as taught by Applicant. Elsewhere in the reference (col. 5, ll. 48-60, esp. ll. 54-57) Vanden Heuvel teaches use of icons (206a, 206b, 206c) to "indicate that three screens have been preselected by the user for display during quick view operation." This passage speaks of a

PATENT

relationship between the number of external states selected and the number of icons displayed, rather than an association of a particular external state with a particular indication on the display. As further clarified in the reference (col. 8, ll. 5–9), a screen may be automatically inserted as a quick view screen in response to a trigger, in which case the “[f]lag-shaped screen icon 206d indicates that a fourth screen has automatically been inserted for quick view display” (col. 5, ll. 57–59). Given that a large number of screens may be inserted, the flag icon may refer to a number of automatically inserted external states. In addition, given a limitation on the number of entries available, e.g., twenty in a preferred embodiment, deletion and insertion operations will necessarily reassign certain triangles 206 to different external states.

To further clarify Applicant's position, claim 1 has been ***amended*** to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention. The amendment introduces no new matter and is fully supported by the specification as originally filed.

Claim 1, ***as amended***, recites in part:

associating a first user-specified indication on the display with
a user-defined external state;

Applicant submits that Vanden Heuvel does not teach or suggest associating a first user-specified indication on the display with a user-defined external state. Since Vanden Heuvel does not disclose each of the elements of claim 1, the rejection under 35 USC § 102(b) should be withdrawn.

Furthermore, Vanden Heuvel does not recognize, nor does any art of record, including art cited but not relied upon, the desirability of associating user-specified indications with monitorable user-defined external states, providing no motivation for combining bits and pieces of prior art references to provide the functionality of Applicant's inventive method of presenting information on space-constrained displays.

Applicant therefore submits that claim 1, ***as amended***, is in condition for allowance over all art of record, and respectfully requests the Office to withdraw its rejection.

PATENT

Claims 2, 6-8, 11, 13, 18-19, and 33, being dependent from allowable amended claim 1 and incorporating all the limitations thereof, are for at least this reason themselves allowable. Applicant therefore requests the Office to withdraw its rejection of claims 2, 6-8, 11, 13, 18-19, and 33.

Claim 3

In rejecting claim 3, the Office asserts that Vanden Heuvel teaches, in addition to those elements cited above in the discussion of claim 1: performing the established user-defined operation using a networked computational service remote from the portable device; and supplying the information encoding in correspondence with a result of the performed user-defined operation.

As explained in more detail *supra*, Applicant respectfully disagrees with the Office's assertion that Vanden Heuvel teaches "associating a first indication on the display with a user-defined external state." Applicant also respectfully disagrees with the Office's interpretation of the cited portion of Vanden Heuvel (Fig. 9, col. 7, line 60 to col. 8, line 9) as teaching "updating the first indication on the display."

Nevertheless, claim 3 has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

Claim 3, *as amended*, recites in part:

associating a first user-specified indication on the display with
a user-defined external state;

Applicant submits that Vanden Heuvel does not teach or suggest associating a first user-specified indication on the display with a user-defined external state. Since Vanden Heuvel does not disclose each of the elements of claim 3, the rejection under 35 USC § 102(b) should be withdrawn.

Furthermore, Vanden Heuvel does not recognize, nor does any art of record, including art cited but not relied upon, the desirability of associating user-specified indications with monitorable user-defined external states, providing no motivation for combining disparate

PATENT

elements of prior art references to provide the functionality of Applicant's inventive method of presenting information on space-constrained displays.

Applicant therefore submits that claim 3, *as amended*, is in condition for allowance over all art of record, and respectfully requests the Office to withdraw its rejection.

Claims 4-5, being dependent from allowable amended claim 3 and incorporating all the limitations thereof, are for at least this reason themselves allowable. Applicant therefore requests the Office to withdraw its rejection of claims 4-5.

Claim 25

The Office rejected claim 25 for the same reasons it rejected claim 1. Applicant respectfully disagrees with the Office's rejections for at least the reasons cited *supra* in the discussion of the allowability of claim 1.

In addition, claim 25 has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

Claim 25, *as amended*, recites in part:

a first functional sequence executable to establish an association between plural user-specified indications on a display of a portable device and respective user-defined external states;

Applicant submits that Vanden Heuvel does not teach or suggest establishing an association between plural user-specified indications on a display of a portable device and respective user-defined external states. Since Vanden Heuvel does not disclose each of the elements of claim 25, the rejection under 35 USC § 102(b) should be withdrawn.

Furthermore, Vanden Heuvel does not recognize, nor does any art of record, including art cited but not relied upon, the desirability of establishing an association between plural user-specified indications on a display of a portable device and respective user-defined external states, providing no motivation for combining pieces from assorted prior art references to provide the

PATENT

functionality of Applicant's inventive method of presenting information on space-constrained displays.

Applicant therefore submits that claim 25, *as amended*, is in condition for allowance over all art of record, and respectfully requests the Office to withdraw its rejection.

Claims 26-27 and 30, being dependent from allowable amended claim 25 and incorporating all the limitations thereof, are for at least this reason themselves allowable. Applicant therefore requests the Office to withdraw its rejection of claims 26-27 and 30.

Claim 31

The Office rejected claim 31 for the same reasons it rejected claim 1. Applicant respectfully disagrees with the Office's rejections for at least the reasons cited *supra* in the discussion of the allowability of claim 1.

Nevertheless, claim 31 has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

Claim 31, *as amended*, recites:

An apparatus comprising:

means for presenting a user-specified visual indication on a display device;
means for associating, based on a user selection, the visual indication with a state external to the apparatus; and
means for receiving an information encoding corresponding to the external state and for updating the visual indication based thereon.

Applicant submits that Vanden Heuvel does not teach or suggest presenting a user-specified indication on a display device or means therefor. Since Vanden Heuvel does not disclose each of the elements of claim 31, the rejection under 35 USC § 102(b) should be withdrawn.

PATENT

Furthermore, Vanden Heuvel does not recognize, nor does any art of record, including art cited but not relied upon, the desirability of presenting a user-specified indication on a display device and associating it with a user-defined external state, providing no motivation for combining portions of prior art references *ad hoc* to provide the functionality of Applicant's inventive method of presenting information on space-constrained displays.

Applicant therefore submits that claim 31, *as amended*, is in condition for allowance over all art of record, and respectfully requests the Office to withdraw its rejection.

Claim 32, being dependent from allowable amended claim 31 and incorporating all the limitations thereof, is for at least this reason themselves allowable. Applicant therefore requests the Office to withdraw its rejection of claim 32.

Rejections Under 35 U.S.C. §103

Claims 9-10 and 12

Claims 9-10 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Vanden Heuvel in view of U.S. Patent No. 6,690,394 issued to Harui (hereinafter "Harui"). Specifically, the Office relied on Vanden Heuvel to provide the teachings of the broad claims, and relied on Harui to provide elements recited in each of the dependent claims 9-10 and 12.

Claim 1, from which claims 9-10 and 12 depend, has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention. Neither Vanden Heuvel, Harui, nor any art of record, including art cited but not relied upon, discloses nor suggests *associating a first user-specified indication on the display with a user-defined external state*, as positively recited in amended claim 1.

Claims 9-10 and 12, being dependent from allowable amended claim 1 and incorporating all the limitations thereof, are for at least this reason themselves allowable. Applicant therefore requests the Office to withdraw its rejection of claims 9-10 and 12.

PATENT

Claims 17 and 36-37

Claims 17 and 36-37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Vanden Heuvel.

Claim 1, from which claims 17, 36, and, through its dependence from claim 36, 37 depend, has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention. Neither Vanden Heuvel nor any art of record, including art cited but not relied upon, discloses nor suggests *associating a first user-specified indication on the display with a user-defined external state*, as positively recited in amended claim 1.

Claims 17 and 36-37, being ultimately dependent from allowable amended claim 1 and incorporating all the limitations thereof, are for at least this reason themselves allowable. Applicant therefore requests the Office to withdraw its rejection of claims 17 and 36-37.

Claims 20-24

Claims 20-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Vanden Heuvel in view of U.S. Patent No. 6,297,945 issued to Yamamoto (hereinafter "Yamamoto").

In rejecting claim 20, the Office refers to figures 4, 7, 9, and 11 of Yamamoto and the accompanying description. Specifically, the Office asserts that columns 1-4 of Yamamoto teach using multiple displays to present more information to the user, and that it would be obvious to use these multiple displays in the mobile terminal of Armstrong [sic] or, presumably, Vanden Heuvel.

With respect, Applicant submits that Yamamoto does not offer a method of presenting information on a space-constrained device display. Rather, Yamamoto offers an apparatus with multiple device displays to provide more room for conventional data display methods, removing any motivation to use alternative display methods or to combine them with his displays. Therefore, even if one were to combine the multiple displays of Yamamoto with the mobile terminal of Armstrong or the portable device of Vanden Heuvel, Applicant's invention would not result.

PATENT

Nonetheless, claim 20 has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

Claim 20, *as amended*, recites in part:

A portable device comprising:

a space-constrained display including a two-dimensional array of user-specified display elements suitable for simultaneously presenting plural visual indications displaced throughout at least a portion thereof;

Applicant submits that neither Vanden Heuvel, Yamamoto, Armstrong, nor any other art of record, including art cited but not relied upon, discloses nor suggests the use of a two-dimensional array of user-specified display elements suitable for simultaneously presenting plural visual indications to present information on a space-constrained display of a portable device. Since all the elements of claim 20 are not found in the prior art, no *prima facie* case of obviousness has been made out with respect to claim 20.

Furthermore, Vanden Heuvel does not recognize, nor does Yamamoto, Armstrong, nor any other art of record, including art cited but not relied upon, the desirability of using a two-dimensional array of user-specified display elements for simultaneously presenting plural visual indications, providing no motivation for combining of prior art references with hindsight to provide the functionality of Applicant's inventive method of presenting information on space-constrained displays.

Applicant therefore submits that claim 20, *as amended*, is in condition for allowance over all art of record, and respectfully requests the Office to withdraw its rejection under 35 U.S.C. §103(a).

Claims 21–24, being dependent from allowable amended claim 20 and incorporating all the limitations thereof, are for at least this reason themselves allowable. Applicant therefore requests the Office to withdraw its rejection of claims 21–24 under 35 U.S.C. §103(a).

PATENT

Claim 28

Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over Vanden Heuvel in view of U.S. Patent No. 6,556,217 issued to Makipaa et al. (hereinafter "Makipaa").

Claim 25, from which claim 28 depends, has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

Claim 25, *as amended*, recites in part:

a first functional sequence executable to establish an association between plural user-specified indications on a display of a portable device and respective user-defined external states;

Applicant submits that neither Vanden Heuvel nor Makipaa, nor any other art of record, teaches nor suggests establishing an association between plural user-specified indications on a display of a portable device and respective user-defined external states. Since all the elements of claim 25 are not found in the prior art, no *prima facie* case of obviousness has been made out with respect to claim 25.

Furthermore, Vanden Heuvel does not recognize, nor does Makipaa nor any other art of record, including art cited but not relied upon, the desirability of establishing an association between plural user-specified indications on a display of a portable device and respective user-defined external states, providing no motivation for combining fragments of earlier references to provide the functionality of Applicant's inventive method of presenting information on space-constrained displays.

Applicant therefore submits that claim 25, *as amended*, is in condition for allowance over all art of record, and respectfully requests the Office to withdraw its rejection under 35 U.S.C. §103(a).

Claim 28, being dependent from allowable amended claim 25 and incorporating all the limitations thereof, is for at least this reason itself allowable. Applicant therefore requests the Office to withdraw its rejection of claim 28 under 35 U.S.C. §103(a).

PATENT

Addition of Claims 41-43

Claims 41-43 have been added to more fully claim the subject matter to which Applicant believes he is entitled. No new matter has been introduced by these claims, and the claims are fully supported by the specification as originally filed.

Claims 41-43 are believed to be allowable over the art of record. None of the cited art teaches or suggests associating a user-specified indication with a user-defined external state. Neither does any of the cited art teach or suggest specifying an associable indication by selecting it from a predetermined list, as recited in claim 41, or by defining it, as recited in claim 42. Neither does any of the cited art disclose a user-specified indication comprising a user-specified portion of the display, as recited in claim 43.

Claims 41-43 are also believed to be allowable over the art of record because, for the reasons set forth above, claim 1, from which each of these claims depends, is allowable *as amended*. For at least these reasons, therefore, the Applicant respectfully requests the Office to allow claims 41-43.

Allowed Claims

Claims 14-16, 34, 35 and 38-40 are allowed.

Claims 14 and 15 have been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention, and to conform their language with that of the other independent claims.

Claim Objections

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 25, from which claim 29 depends, has been *amended* to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention, placing it, as

PATENT

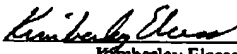
described in more detail above, in condition for allowance. Applicant therefore respectfully requests that the claim be allowed as currently presented.

Interview Summary

On July 26, 2005 the undersigned, along with David W. O'Brien, held a teleconference with Examiner Trinh regarding the above-cited application. Examiner Trinh indicated that, upon reflection, the Sugita reference (U.S. Patent No. 6,075,778) did not support the rejections made in the presently outstanding Office Action. He indicated that the claims were likely allowable over the art presently of record, but instead drew Applicant's attention to a new reference, U.S. Patent No. 6,567,671, which Examiner Trinh agreed to make of record.

Conclusion

In summary, claims 1-43 are in the case. All claims are believed to be allowable over the art of record, and a Notice of Allowance to that effect is respectfully solicited. Nonetheless, if any issues remain that could be more efficiently handled by telephone, the Examiner is requested to call the undersigned at the number listed below.

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Respectfully submitted,



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